

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

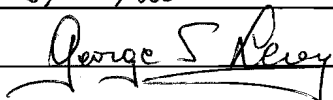
Docket Number (Optional)

050601

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 05/04/2007

Signature



Typed or printed name

GEORGE S. LEVY

Application Number

10/663,419

Filed

09/16/2003

First Named Inventor

SACKS, ABRAHAM ET AL.

Art Unit

3635

Examiner

HORTON, YVONNE

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. ✓

This request is being filed with a notice of appeal. ✓

The review is requested for the reason(s) stated on the attached sheet(s). ✓

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

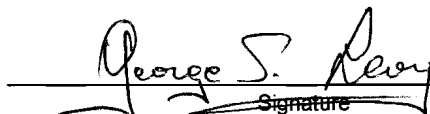
attorney or agent of record.

Registration number \_\_\_\_\_

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



GEORGE S. LEVY

Typed or printed name

(858) 259-2226

Telephone number

05/04/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Title: IMPROVED TWIN TRACK WIRE LATH  
Application No.: 10/663,419  
Filing Date: 09/16/2003  
Inventor: SACKS, Abraham et al.  
Group Art Unit: 3635  
Examiner: HORTON, Yvonne Michele  
Attorney Docket No: 050601  
Date: 05/04/2007

To: Commissioner for Patents, USPTO  
P.O. Box 1450, Alexandria VA 22313-1450

Attn: Examiner Horton:

**JUSTIFICATION FOR REQUEST FOR REVIEW**

This document accompanies a notice of appeal re-instating a previous appeal filed on 04/22/2005. It is a requirement for a pre-appeal request for review.

**With Regards Withdrawal of Allowable Matter**

In the office action dated 02/09/2007 the examiner allowed claim 3:

***Allowable Subject Matter***

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

We followed the examiner's suggestion to the letter and submitted on 03//09/2007 an amended claim 1 with all of the restrictions of claim 3.

In the last office action dated 04/10/2007, the examiner reversed herself using the same prior art (DOUTHWAITE Patent #4,003,178). The examiner has been aware of this prior art for at least the two previous office actions of 09/05/2006, and 09/03/2007. In addition, she has been aware of a similar prior art, JAENSON since the beginning of the prosecution nearly 3 years ago. This piecemeal examination is unacceptable. Relevant passages from the MPEP are included below for reference:

#### **706.04 Rejection of Previously Allowed Claims [R-1]**

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

#### **707.02 Applications Up for Third Action and 5-Year Applications [R-2]**

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent \*>Office< action with a view to finally concluding its prosecution.

#### **707.07(g) Piecemeal Examination**

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

### **With Regards Claim Rejection – 35 USC 103**

On page 3 of her response, the examiner declared that the term “wound into rolls” in claim 1 is a method step. This is inaccurate. If the claim were using a past participle phrase as in “the step of winding into roll” then this phrase would be referring to a method. However, it is clear that the phrase “wound into rolls” is a state of the object.

On pages 5 and 6 of the examiner’s response, she asserted that rigidity can be controlled by changing the cross section of the wires, the depth of the spacing furrs and the spacing of the wires in the grid. As already mentioned in previous responses to office actions, we agreed that the prior art wire lath can be bent. Indeed, even the moduli of rigidity (compression, tension or shear) of diamond is not infinite and a diamond sheet of sufficient thinness could be bent probably with a radius of curvature of a few inches. Of concern here is a fundamental USC 101 issue, that is, comparing the utility of the current invention with the utility of prior art (DOUTHWAITE and JAENSON) assuming all factors are the same across the comparison except of course what makes this invention different. In other words, the comparison should be fair. Those factors which should remain constant include the thickness of the wires, the wire spacing in the lath and the depth of the spacing furrs. One reason for keeping these factors constant is that changing them has economic and technical consequences and this is precisely the source of the greater utility for this invention. A lath with a higher wire density or wire thickness costs more, is heavier, and therefore has lower utility. A lath with shallower furrs loses the ability to create a space between itself and the supporting surface, thus adversely affecting the application of the stucco. Making such unfair comparisons actually leads to the invalidation of the prior art since under such conditions of wire thinness, large wire spacing and small furr depth the prior art product is definitely inferior, has lower utility and therefore ceases to be valid prior art under USC 101. A telling fact is that competitive and comparable laths that do not make use of this invention are currently sold in flat panels. Conversely laths that are constructed according to this invention are sold in rolls with significant savings in transportation costs.

The following paragraphs are summaries of excerpts of key documents that were presented during the prosecution and will help in understanding the problems involved in the obviousness rejection by the examiner.

### **1. Reason for Increased Flexibility of this Invention.**

This is a summary of excerpt (pages 2 to 6) of the document filed on 12/04/2006 entitled in the record as “Applicant Arguments/Remarks Made in an Amendment. Summary: One of the key differences between the prior art and this invention is the position of the longitudinal wires with respect the furrs indented in the transverse wires. In the prior art, some longitudinal wires are located on the tip of the furrs, thus creating a 3-dimensional and rigid trellis. In this invention the furrs are located between the longitudinal wires or equivalently, the longitudinal wires are not located in the furrs. This arrangement allows the lath structure to remain essentially 2-dimensional and flexible. Of course, one can increase the flexibility of the prior art product by reducing the thickness of the wires, increasing the spacing between the wires and reducing the size of the furrs. This leads however to an unfair comparison in which the utility of the prior art product is diminished thus negating its validity as prior art under USC 101 and USC 112p1.

### **2. Economic analysis**

This is a summary of excerpts from responses submitted on November 12 2005 (pages 5 and 6) and on 11/17/2007 (pages 2 and 3).

Summary: The saving in shipping costs is significant. The cost of shipping in rolls competing products which cannot easily be rolled is about \$91.60 per roll. The cost of shipping our product is \$1.87 per roll. For more detail see the appendix. It is precisely for this reason that competing products are sold in panels, not in rolls.

### **3. Flexibility tests**

This is a summary of documents filed on 11/17/2005 submitted on 11/17/2005.

Summary: These tests have been conducted on our product and on competing products having the JAENSON and DOUTHWAITE construction. It is clear from the results of these tests that winding competing products into rolls of approximately one foot diameter, distort their furr structure and therefore renders them non-functional. Our product, however keeps its shape and functionality. The tests were conducted in a fair manner: all wire diameters were the same, the wire spacing was equivalent and the depth of the furrs was identical. Given the loss of utility of the prior art products under rolled conditions, they cease to be relevant prior art under 35USC 101 and 35 USC 112p1.

#### **4. Letter from Expert**

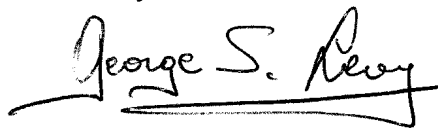
This is a summary of a letter submitted on 12/05/2006 written by Dr. Perry Adebar, Consulting Structural Engineer and Professor and Associate Dean at the University of British Columbia.

Summary: Dr. Adebar referenced the loss of utility of the prior art product when rolled. Dr. Adebar concludes:

*“Based on an inspection of samples of welded wire lathing as disclosed in US Patent 5,540,023 by Jaenson, a rational analysis of this product using the principles of structural engineering, and the results of an experimental study on this product, it is my expert professional opinion that this product cannot be rolled without damaging it to a point that it no longer meets its intended use.”*

His conclusion is also applicable to the DOUTHWAITE patent in which as in the JAENSON patent, the transverse wire are placed at the tip of the spacing furrs.

Sincerely Yours

A handwritten signature in black ink that reads "George S. Levy". The signature is written in a cursive style with a horizontal line underneath the name.

George Levy, Reg.

No 53211 (858)259-2226